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EXAMINER

WILSON, JOHN J

ART UNIT PAPER NUMBER

3732

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/784,677

Applicant(s)

GUGEL ET AL.

Examiner

John J. Wilson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32, 34 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Mabile (4676749). Conger shows a hand piece 1, handle 4, hollow needle 13, for discharge of abrasive "A", Fig. 2, and fluid, column 4, lines 2-14, coupling terminal 2 connected to a supply line 3 and means 12 for detachably connecting the needle 13, column 4, lines 23-48. Connection 12 is threaded, which is held to be inherently fast acting. Conger does not show a reduced cross section. Mabile shows using a reduced cross section, Fig. 1, column 3, lines 58-65. It would be obvious to one of ordinary skill in the art to modify Conger to include a reduced cross section as shown by Mabile in order to better fit the elements within the tip as shown. As to claim 40, Conger teaches the coupling is for gas, air and therapeutic agent, that is, water, column 3, line 60 through column 4, line 2.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Mabile (4676749) as applied to claim 32 above, and further in view of Tilden (2814877). Conger shows a treaded connection at 12, however, the above combination does not show a bayonet connection. Tilden teaches that it is

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known to use the alternatives of treaded or bayonet connections when attaching nozzles, column 4, lines 60-64. It would be obvious to one of ordinary skill in the art to modify the above combination to include a bayonet connection as shown by Tilden in order to make use of art known alternatives to best attach a nozzle to an abrasive tool.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Mabile (4676749) as applied to claim 32 above, and further in view of Maurer et al (2643456). The above combination does not show a plurality of needles having different shapes, sizes and opening sizes. Maurer teaches using a plurality of needles having different shapes and opening sizes, Figs. 12-21. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a plurality of nozzles as shown by Maurer in order to better apply the abrasive in the desired manner. That different sizes can be used is an obvious matter of choice in the size of known elements to one of ordinary skill in the art in order to best reach desired areas in the mouth of the patient.

Claims 36, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Mabile (4676749) as applied to claim 32 above, and further in view of Landgraf et al (4198755). The above combination does not show rotating sleeves. Landgraf shows using rotating sleeves (22, 23) and 54. It would be obvious to one of ordinary skill in the art to modify the above combination to include

using rotating sleeves as shown by Landgraf in order to allow for easier positioning of the tool within the mouth of the patient.

Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Mabile (4676749) and Landgraf et al (4198755) as applied to claim 36 above, and further in view of Karst (4950160). Conger shows the structure as described above, and further shows locating the supply at an angle to the longitudinal axis of the hand piece while locating the coupling means on the axis, and as such, the above combination does not show reversing the location of these elements. Karst shows locating the coupling means as shown at the bottom of 12, at an angle to the longitudinal axis. It would be obvious to one of ordinary skill in the art to modify the above combination to include locating the coupling means at an angle as shown by Karst in order to choose the desired location of known elements so as to enable a better grip of the instrument. As to claim 38, Karst shows the storage container 18 being located at the rear. The specific location is merely a matter of the location of known elements to the skilled artisan. As to claim 39, the specific relative location of these elements is also an obvious matter of choice in the location of known element to one of ordinary skill in the art.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Mabile (4676749) as applied to claim 40 above, and further in view of Saupe et al (4696645). The above combination does not show arranging the

gas feed line at the rear of the therapeutic line. Saupe shows locating feed line 90, Fig. 7, at the rear of feed line 87. It would be obvious to one of ordinary skill in the art to modify the above combination to include locating one feed line to the rear of another as shown by Saupe in order to make use of known locations of elements in coupling members to best couple the elements together.

Claims 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Landgraf et al (4198755). Conger shows the structure as described above, however, does not show rotating sleeves. Landgraf shows using rotating sleeves (22, 23) and 54. It would be obvious to one of ordinary skill in the art to modify Conger to include using rotating sleeves as shown by Landgraf in order to allow for easier positioning of the tool within the mouth of the patient.

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Maurer et al (2643456) and Fischer (5289919). Conger shows a hand piece 1, handle 4, hollow needle 13, for discharge of abrasive "A", Fig. 2, and fluid, column 4, lines 2-14, coupling terminal 2 connected to a supply line 3 and means 12 for detachably connecting the needle 13, column 4, lines 23-48. Connection 12 is threaded, which is held to be inherently fast acting. Conger does not show a plurality of needles having different shapes, sizes and opening sizes. Maurer teaches using a plurality of needles having different shapes and opening sizes, Figs. 12-21. It would be

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obvious to one of ordinary skill in the art to modify Conger to include using a plurality of nozzles as shown by Maurer in order to better apply the abrasive in the desired manner. The above combination does not show using colored markings. Fischer teaches different size tips having color markings, column 4, lines 12-25. It would be obvious to one of ordinary skill in the art to modify the above combination to include color markings as shown by Fischer in order to distinguish the different tips used. To associate the color markings with different therapeutic agents is merely a matter of mental interpretation and/or intended use of indicia, and as such, the actual claimed structure being shown, is not given patentable weight.

### ***Response to Arguments***

Applicant's arguments filed September 14, 2006 have been fully considered but they are not persuasive. With respect to claims 44 and 45, Landgraf is suggestive of the combination because it is for solving the same problem of allowing the working end of a dental tool that is connected to a fluid supply to rotate with respect to the supply to better position the tool in use. With respect to the remaining claims, applicant's remarks are held to be moot in view of the newly applied references above.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Epstein (5342327) teaches associating color with therapeutic agents, column 3, lines 12-14.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached at 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**John J. Wilson**  
**Primary Examiner**  
**Art Unit 3732**

jjw

October 31, 2006